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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BUMGARNER, MELBA N

ART UNIT PAPER NUMBER

3732

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/632,811

Applicant(s)

SAITO ET AL.

Examiner

Melba Bumgarner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-14 is/are pending in the application.
- 4a) Of the above claim(s) 9-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The disclosure is objected to because its contents appear to be a literal translation into English from a foreign document and is replete with grammatical and idiomatic errors, for example on page 2 “facing cast bride”. Appropriate correction is required.

Election/Restrictions

2. Newly submitted claims 9-14 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new claims are directed to a method of using the product of the original claims. The product of the original claims can be used in a materially different process of using that product such as attaching to an abutment and dental implant in a jawbone. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 9-14 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 2-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims appear to recite part of the human body in combination with the structure of the claimed invention, for example, “a lingual side tooth”. It has been held that a claim directed to or including within its scope, a human being will not be considered to be

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patentable subject matter under 35 USC 101. The grant of limited, but exclusive property right in a human being is prohibited by the Constitution. *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970). Applicant needs to clearly state using inferential language that the human anatomy is not claimed. For examination purposes, the claims will be considered as if such limitations involving the combination with a human were not present.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the claims, it is unclear what is claimed as the limitations of the prosthesis, for example, if a polymer of a mixture of a polymerizable compound is in addition to resin material.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 2 and 4-6 are rejected as understood, under 35 U.S.C. 102(b) as being anticipated by Ai et al. (4,909,738). Ai et al. disclose a prosthesis including a polymer of a mixture of a polymerizable compound having an unsaturated double bond (column 5 line 31), a filler (column 6 line 6), and a polymerization initiator (column 5 line 50), a prosthetic surface having a shape resembling a labial side surface of an anterior tooth, a back surface (figures 1-3). A prosthetic

surface has a shape resembling buccal side surface and an approximal surface. As to claim 2, the prosthetic surface has a thickness of 0.5 to 5.0 mm.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3/(2 and 4-6) is rejected as understood, under 35 U.S.C. 103(a) as being unpatentable over Ai et al. in view of Neustadter (2,948,963). Ai et al. disclose a prosthesis that shows the limitations as described above and a protrusion on the back surface; however, they do not show the protrusion having a hole. Neustadter teaches a prosthesis having on the back surface, a protrusion having a hole 22. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the protrusion of Ai et al. to have the hole in the protrusion as in Neustadter in order to have the hole support a supporting structure to more firmly secure the prosthesis in view of Neustadter.

11. Claims 7 and 8 are rejected as understood, under 35 U.S.C. 103(a) as being unpatentable over Ai et al. in view of Hiranuma et al. Ai et al. disclose a prosthesis that shows the limitations as described above; however, they do not show the various shapes the prosthetic surface resembles. Hiranuma et al. teach a prosthesis including a prosthetic surface resembling an occlusal surface of a molar tooth (figure 5). It would have also been obvious to one of ordinary skill in the art at the time the invention was made to have the prosthesis of Ai et al. include the

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configuration of Hiranuma et al. in order to use the prosthesis for a molar-tooth portion in view of Hiranuma et al.

12. Claim 3/7-8 is rejected as understood, under 35 U.S.C. 103(a) as being unpatentable over Ai et al. in view of Hiranuma et al. and further in view of Neustadter. The modified prosthesis of Ai et al. and Hiranuma et al. disclose a prosthesis that shows the limitations as described above and a protrusion on the back surface; however, they do not show the protrusion having a hole. Neustadter teaches a prosthesis having on the back surface, a protrusion having a hole 22. It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the protrusion of Ai et al. to have the hole in the protrusion as in Neustadter in order to have the hole support a supporting structure to more firmly secure the prosthesis in view of Neustadter.

Response to Arguments

13. Applicant's arguments filed November 24, 2004 have been fully considered but they are not persuasive. The prior art show the structural limitations as claimed as understood. In response to applicant's argument that the prior art reference describes the prosthesis configured to be connected to a retainer or connector and not an abutment tooth, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or other communication from the examiner should be directed to Melba Bumgarner whose telephone number is 703-305-0740. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Melba Bumgarner". The signature is fluid and cursive, with the first name "Melba" and last name "Bumgarner" clearly distinguishable.

Melba Bumgarner
Patent Examiner